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Paper No. 84

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DEC 23 2002

OFFICE OF PETITIONS

In re Application of:
Linda H. Malkas, Robert J. Hickey,
Pamela E. Betchel, Min Park,
Derek J. Hoelz, Dragana Tomic and
Lauren Schnaper
Application No. 10/083,576
Filed: February 27, 2002
Title of Invention: METHOD FOR
PURIFYING CANCER-SPECIFIC
PROLIFERATING CELL NUCLEAR ANTIGEN

DECISION REFUSING
STATUS
UNDER 37 CFR 1.47(a)

This Decision is in response to a Petition Under 37 C.F.R. 1.47(b), filed October 22, 2002, which is being treated as a petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). A five (5) month extension of time is requested and is hereby granted.

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 27, 2002, without a fully executed oath or declaration. Accordingly, on March 22, 2002 a "Notice to File Missing Parts of Nonprovisional Application" hereinafter "Notice", was mailed to Petitioner. The Notice required, in relevant part, a fully executed oath or declaration. Applicant was given two-months from the date of the Notice within which to file a fully executed oath or declaration. Extensions of time were available under 37 CFR 1.136(a).

Petitioner responds with the instant petition, extension-of-time request, and Declaration of David L. Marks and Dawn M. Brosius hereinafter the "Marks/Brosius Declaration". The Marks/Brosius Declaration avers, in relevant part, that the nonsigning inventor was sent a copy of the above-identified application at her last known work address. Marks/Brosius Declaration at p. 1.

Applicable Law:

and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

As to item (1), the applicant has failed to establish that the nonsigning inventor was ever presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. Emphasis supplied.

MPEP 409.03(d).

As required by the MPEP, a copy of the application should be sent to the last known address of the nonsigning inventor(s). The last known address should be the last known residence at which the inventor customarily receives mail. See, MPEP 409.03(e) and 605.03.

Petitioner must send a copy of the entire application, including the specification, claims and drawings, along with the oath or declaration to the nonsigning inventor at the last known address of the inventor before refusal can be alleged.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 305-6914
Attn: Office of Petitioning

By Email: Crystal Blain Fann, Patent Clerk
400 S. Clark Place
Arlington, VA 22204

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-5014.

John H. ...